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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,631	10/09/2001	Gordon R. Boyes	60426-359 2001E18432US	9389

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
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EXAMINER

BRYANT, DAVID P

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

Office Action Summary

Application No.

09/974,631

Applicant(s)

BOYES ET AL.

Examiner

David P. Bryant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims make reference to “a thermal mastic elastomeric material” and/or “a non-foamed base” and/or a “thermal mastic blend material base”. However, the specification provides no description of what these materials actually comprise.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27:

In line 4, “said neck” lacks proper antecedent.

In line 7, “said lower shell” lacks proper antecedent.

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Claim 31:

In lines 4-5, "said neck" and "said lower shell" lack proper antecedent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Applicant's admitted prior art (AAPA) in view of Balderrama (U.S. Patent No. 5,108,524).

AAPA is found on page 1 of the specification, where it is disclosed that an air induction assembly is typically provided with a "peel and stick" type foam gasket material. With such a gasket, a pre-manufactured gasket is provided with an adhesive backing, and is disposed on a piece of wax paper. In use, the gasket is peeled off the wax paper and applied to the desired surface of the air induction assembly (e.g. the neck of a lower shell of the air induction assembly). Thereafter, as is known in the art, another component of the air induction assembly (e.g. a mass air flow sensor) is situated against the gasketed portion to form an airtight seal.

AAPA fails to teach providing the gasket on the desired surface by applying a liquid form of thermal mastic elastomeric material thereon.

Balderrama teaches a method for applying a hot melt gasket **24** around the neck of a container prior to applying a cover **16/19** thereon. As depicted in Figures 8 and 9 and disclosed in column 2 (lines 2-10 and 36-41), a hot melt unit **27** includes a supply of hot melt material (i.e.

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liquid thermal mastic elastomeric material), which is heated by a heater 29 to melt and maintain the hot melt material in a molten state. Nitrogen is supplied from pressure tank 31 into the hot melt material to form a foamed hot melt material. As depicted in Figures 1-3, the foamed material is fed from a nozzle 26 to a lip surface 17 of the container, and is then allowed to cure at room temperature prior to assembly of the container. As disclosed in column 1 (lines 10-52), the hot melt gasket is intended to replace pre-manufactured gaskets which often provide inadequate sealing, and which made it is necessary for a dispenser supplier to have numerous gaskets on hand of various sizes to meet the needs of its customers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the gasket of AAPA from foamed hot melt material, as taught by Balderrama, to provide a gasket with improved sealing ability, while obviating the need for manufacturing numerous gaskets of various sizes.

Claims 24, 25, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of Balderrama (U.S. Patent No. 5,108,524), as applied to claim 19 above, and further in view of Shimada et al. (U.S. Patent No. 6,241,936).

The combination of AAPA/Balderrama teaches all claimed steps, with the exception of positioning a mold around the neck of the lower shell of the air induction assembly to form the gasket with a desired shape.

Shimada et al. teach a method of forming a foamed gasket 20 around the neck 16 of a component, the method comprising positioning a mold 30 positioned around an interior surface and an exterior surface of the neck, dispensing melted elastomeric foamed material through

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nozzle 34 into a mold surface 32 of the mold, and removing the neck and attached gasket 20 from the mold. See Figures 3A-3D.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a mold in the formation of the hot melt gasket of AAPA/Balderrama, as taught by Shimada et al., to more accurately provide a desired shape to the finished gasket.

Claims 26 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of Balderrama (U.S. Patent No. 5,108,524), as applied to claim 22 above, and further in view of either of Wilbur (U.S. Patent No. 339,036), Schwarz (U.S. Patent No. 3,606,401), or Young (U.S. Patent No. 2,686,091) [hereinafter referred to as "the secondary references"].

The combination of AAPA/Balderrama teaches all claimed steps, with the exception of dispensing the liquid elastomeric material through an aperture in the neck of the lower shell and between the neck and the mass air flow sensor to secure the mass air flow sensor to the neck.

The secondary references each teach securing an inner tubular component within an outer tubular component by inserting the inner component telescopically within the outer component, and dispensing a liquid thermoplastic material through an aperture in the outer component and between the inner and outer component to secure the components together.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the gasket between the neck of the lower shell and the mass air flow sensor of AAPA/Balderrama by dispensing the liquid elastomeric material through an aperture in the neck and between the neck and the mass air flow sensor, as taught by the secondary

references, to self-locate the gasket between the neck of the lower shell and the mass air flow sensor and secure the components together in a single assembly step.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The majority of the references have been cited for disclosing gasket forming techniques similar to applicant's invention.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **David Bryant** whose telephone number is **(703) 308-1859**. Draft amendments or proposed changes to the application may be faxed directly to the examiner at any time via RightFAX at (703) 746-4213. The examiner can normally be reached on **Mondays-Thursdays from 6:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



David P. Bryant
Primary Examiner
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